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Hermann Gmeinder

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EXAMINER

JARRETT, RYAN A

ART UNIT

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2121

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,413	Applicant(s) GMEINDER ET AL.	
	Examiner RYAN A. JARRETT	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 14-16 and 19-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 13, 17, and 18 in the reply filed on 10/23/08 is acknowledged.

Claims 1-12, 14-16 and 19-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the replies filed on 07/17/08 and 10/23/08.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

The drawings filed 04/10/06 are informal and are acceptable for examination purposes only. For example, Fig. 4 is difficult to discern.

Response to Arguments

Applicant's arguments, see page 8, filed 04/15/09, with respect to claim 18 have been fully considered and are persuasive. The rejection of claim 18 under 35 U.S.C. 112 2nd paragraph has been withdrawn in light of the amendments to claim 18 filed 04/15/09.

Applicant's arguments, see page 9 line 10 – page 10 line 22, filed 04/15/09, have been fully considered but they are not persuasive. Applicant argues that Guthrie et al. does not disclose control information that is independent of the navigation information. This is not persuasive since the navigation information is what moves the cursor on the screen, whereas the control information is what activates the function at the location of the cursor on the screen. Thus, the two are clearly independent. For comparative purposes, take the case of a regular PC mouse. Moving the mouse with your hand (and thus the cursor on the screen) is independent from clicking the mouse button with your finger (and thus clicking the button or function at the location of the cursor).

Likewise, Applicant argues that Neer et al. does not disclose control information that is independent of the navigation information. This is not found persuasive since Neer et al. discloses “Scroll” pedals 122,124 for generating navigation information for the onscreen cursor, and an “Activate” pedal 126 for generating control information for activating the function at the location of the cursor on the screen. The pedals and their associated functions are clearly independent.

Although not separately argued, Examiner concedes that neither Guthrie et al. nor Neer et al. teach the last limitation of amended claim 18, which recites that “the control information generated via the second input element is useable for control of at least one apparatus

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independently of the user interface”. This is because Guthrie et al. and Neer et al. appear to only disclose controlling the apparatuses via the user interface, i.e., by “clicking” or selecting functions displayed on the user interface. Neer et al. does disclose direct control of apparatuses via the foot pedal (independent of control via the display screen), but it is not in the preferred embodiment.

As such, DiRe US 2004/0007907 has been introduced as teaching claim 18. DiRe discloses a wireless control pad in a dental chair for navigating on a display screen, and also for directly controlling apparatuses such as speakers in the chair, independently from the display screen. The amendment to claim 18 necessitated the new ground of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Guthrie et al. US 5,230,623. Guthrie et al. discloses:

13. Dentist's or dental treatment station/work station, comprising

-plural dental work apparatuses and/or examination apparatuses (e.g., Figs. 1-6),

- an input device for the generation and wireless transfer of navigation and/or control information for the activation and control of functions of the apparatuses (e.g., Fig. 6 #609) and

- a functional unit, connected upstream of the apparatuses, which receives the navigation and/or control information transferred from the input device and passes this onto the apparatuses (e.g., Fig. 6 #618),

wherein the input device generates navigation information for the control of a pointer on a user interface, which is represented on a display of the dentist's treatment station (e.g., Fig. 3 and associated descriptions), and control information with which functions of the apparatuses are

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selectable and/or activatable independently of the navigation information (e.g., Fig. 3 and associated descriptions).

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Claims 13 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by DiRe US 2004/0007907. DiRe discloses:

13. Dentist's or dental treatment station/work station, comprising

- plural dental work apparatuses and/or examination apparatuses (e.g., Figs. 1,3),
- an input device for the generation and wireless transfer of navigation and/or control information for the activation and control of functions of the apparatuses (e.g., Figs. 1,3 #40) and
- a functional unit, connected upstream of the apparatuses, which receives the navigation and/or control information transferred from the input device and passes this onto the apparatuses (e.g., Fig. 3 #64),

wherein the input device generates navigation information for the control of a pointer on a user interface, which is represented on a display of the dentist's treatment station (e.g., Figs. 1-3 #42, Fig. 4, [0025]: "all choices are one the desktop display on the screen 42 and accessible with...point-and-click type of control"), and control information with which functions of the apparatuses are selectable and/or activatable independently of the navigation information (e.g., [0018]: "Control of the volume of the speakers 38 is done by the user via a control pad 40 mounted on or in the arm 24").

18. Dentist's or dental treatment/work station according to claim 13, wherein the input device comprises:

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- a first input element for the generation of navigation information for the control of a pointer on the user interface (e.g., Figs. 1-3 #42, Fig. 4, [0025]: “all choices are one the desktop display on the screen 42 and accessible with...point-and-click type of control”),

- at least a second input element for the generation of control information, with which, independently of the navigation information generated by the first input element, functions of the apparatuses are selectable and/or activatable (e.g., [0018]: “Control of the volume of the speakers 38 is done by the user via a control pad 40 mounted on or in the arm 24”), and

- a transfer device for the wireless transfer of the navigation and control information generated with the aid of the first and second input elements to the apparatuses or to a functional unit connected upstream of the apparatuses (e.g., Figs. 1, 3 #40),

wherein the control information generated via the second input element is useable for control of at least one apparatus independently of the user interface (e.g., [0018]: “Control of the volume of the speakers 38 is done by the user via a control pad 40 mounted on or in the arm 24”).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neer et al. US 5,422,521 in view of Uejima et al. US 5,902,105.

Neer et al. discloses all features of claim 13 (e.g., Fig. 1 and Fig. 7 and associated descriptions), except for "wireless transfer" of the information, as recited in claim 13.

However, wireless foot pedals are well known in the dental workstation art, as disclosed by Uejima et al. (e.g., col. 10 line 46 - col. 11 line 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Neer et al. with Uejima et al. since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. See *KSR v. Teleflex*, 127 S.Ct. 1727 (2007).

Also, one would have been motivated to make such a modification since Uejima et al. teaches that with this structure, the installation position of the foot pedal can have higher degree of freedom, thereby improving operability of the foot pedal and eliminating cables which may hinder smooth operation (e.g., col. 11 lines 5-8).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12, 19, and 20 of copending Application No. 10/575,150. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are fully anticipated by the ‘150 application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. JARRETT whose telephone number is (571)272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/
Primary Examiner, Art Unit 2121

06/05/09